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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,860	11/28/2001	Ronald D. Blum	13797/257	9812
23838	7590	05/04/2007		
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
			EXAMINER BOECKMANN, JASON J	
			ART UNIT 3752	PAPER NUMBER
			MAIL DATE 05/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 09/994,860	Applicant(s) BLUM ET AL.	
	Examiner Jason J. Boeckmann	Art Unit 3752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 20-25 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) 20-25 and 27-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/03/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of group 1 claims 1-17 in the reply filed on 2/23/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 20-25 and 27-32 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2/23/2007.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 are rejected under 35 U.S.C. 101 because the disclosed invention is wholly inoperative and therefore lacking credible utility. What has been disclosed is a

concept more in the realm of speculation and conjecture rather than the reduction of an idea to a practical application based on science and technology.

Regarding claim 1, applicant claims a method of making a reduced intensity hurricane by positioning a plurality of submersibles in a hurricane interception area; maneuvering the submersibles to a predetermined depth and releasing a gas during a predetermined amount of time, the gas forming bubbles which rise in plume toward a surface to cool the surface of the ocean, thereby reducing the intensity of the hurricane. In order for an invention or process to have credible utility, the applicant disclosure must contain sufficient evidence and reasoning to permit a person of ordinary skill in the art to believe the asserted utility. In this case, the application does not contain sufficient information to permit a person of ordinary skill in the art to believe that the process disclosed either could be implemented or could achieve the asserted useful result, since applicant has shown no evidence of reducing the speculation and conjecture to practice in either a laboratory or natural environment setting. For example, taking into consideration the enormous size of a hurricane, the process of modifying a hurricane disclosed by applicant would take more than the resource realistically available to mankind.

On the issue of compliance with the utility requirement of 35 U.S.C. 101, the following statement made by the Supreme Court of the United State is on point:

"This is not to say that we mean to disparage the importance of contributions to the fund of scientific information short of the invention of something "useful", or that we are blind to the prospect that what now seems without "use" may

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tomorrow command the grateful attention of the public. But a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion. "[A] patent system must be related to the world of commerce rather than to the realm of philosophy".

See, Brenner v. Manson, 148 USPQ 689, 696 (US SupCt 1966).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which is most nearly connected to make and/or use the invention.

Since the asserted utility is not credible for the reason set forth above, one skilled in the art would not know how to make and use the claimed invention. For example, in claim 1, the assertion that reducing the hurricane intensity by using the submersibles to release a gas to form a plume to cool the surface of the ocean and thereby, to reduce the intensity of the hurricane, is not feasibly supported by the specification in exact terms (i.e. the grand scale or vast area of the release site, the amount of gas that is required to affect the hurricane, the number of submersibles required for the process and the exact size of the submersibles, etc.).

Furthermore, the standard for enablement is whether a person skilled in the art would have sufficient information from the application disclosure to make and use the claimed invention without undue experimentation. In this case, the amount of experimentation necessary to perform the process disclosed would be undue. Undue experimentation would be necessary because:

- The claimed invention is broad and sweeping in scope.
- The nature of the invention is that a large-scale environment change.
- The level of one ordinary skill in the art is best characterized as that of a theoretical scientist dealing in probabilities and possibilities rather than that of an engineer dealing in practical applications of technology.
- The outcome of the disclosed concept is entirely unpredictable.
- The application is devoid of working examples.
- The quantity of experimentation needed to use the invention based on the content of the disclosure can only be characterized as astronomical considering the lack of background information, past experiment, and specific detail.

Response to Arguments

Applicant's arguments filed 9/15/2004 have been fully considered but they are not persuasive. Regarding the 101 and 112 1st rejections, examiner insists that the logic is not flawed and that due to the large nature of a hurricane, it is unrealistic for anyone human or any structure made by man to be capable of reducing the surface temperature of the of the storms central core by 2.5 degrees Celsius. Applicant readily

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admits in his arguments, "submersibles of the kind required for this application do not presently exist." It seems that applicant wishes that someone will come along and develop the technology required to make the required submersibles, thereby enabling the present invention. Therefore, it is impossible for one of ordinary skill in the art at his time to make and or use this invention.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason J. Boeckmann whose telephone number is (571) 272-2708. The examiner can normally be reached on 7:30 - 5:00 m-f, first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJB JSB 4/30/07


Joseph A. Kautman
Primary Examiner
4/30/07